



REMARKS/ARGUMENTS

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The Office Action mailed June 27, 2003 has been reviewed and carefully considered. Claims 1-10, 12-18, 20-22, and 29 are pending in this application, with claim 1 being the only independent claim. Reconsideration of the above-identified application in view of the following remarks, is respectfully requested.

In the Office Action mailed June 27, 2003, claims 1-10, 12-14, 20, 22, and 29 stand rejected under 35 U.S.C. §103 as unpatentable over EP 099 264 (Doyle) in view of U.S. Patent No. 3,921,527 (Raschke) and U.S. Patent No. 4,705,696 (Calabrese). Claim 15 stands rejected under 35 U.S.C. §103 as unpatentable over Doyle, Raschke and Calabrese in view of U.S. Patent No. 3,607, 255 (Back). Claims 16 and 17 stand rejected under 35 U.S.C. §103 as unpatentable over Doyle, Raschke and Calabrese in view of U.S. Patent No. 4,103,616 (Chu). Claim 18 stands rejected under 35 U.S.C. §103 as unpatentable over Doyle Raschke and Calabrese in view of U.S. Patent No. 4,020,762 (Peterson). Claim 21 stands rejected under 35 U.S.C. §103 as unpatentable over Doyle Raschke and Calabrese in view of U.S. Patent No. 3,650,797 (Tomanek).

Doyle discloses a method in which powdered toner particles are applied over an entire surface of a printing form. In a subsequent step an image area is exposed to laser light to melt the powdered toner in the image area so that it is fixed to the printing form. The excess powder, i.e., powder in the non-image area is then removed. Regarding the rejection of independent claim 1 as obvious over Doyle, Raschke, and Calabrese, the Examiner refers to the Decision on Appeal in the Office Action. In the Decision On Appeal, the Board of Patent Appeals and Interferences ('the Board') opined that Doyle teaches that liquid toner and powdered toner are interchangeable and that one skilled in the art would use either one of these types of

toners. The Board based their opinion on page 3, lines 7-9, of Doyle (see page 4, lines 10-13 of the Decision On Appeal). With all due respect, Applicant submits that the Board's interpretation of that sentence in Doyle is misplaced and asks the Examiner to reconsider the rejection in view of the following remarks.

The portion of Doyle referenced by the Board states as follows: "Although the invention enables printing plates to be produced without using a liquid development step, it can if desired be utilized in the manufacture of lithographic printing plates by the conventional photomechanical technique". This sentence does not in any way state that liquid toners can be used instead of powdered toners. Rather, this sentence informs those skilled in the art that even though the invention of Doyle does not include a liquid development step, the invention of Doyle can still be used to make lithographic plates by the conventional photomechanical technique. Doyle discloses a method of imaging a printing form in which powdered toner is charged and applied onto an entire surface area of a printing form. Doyle discloses that the powdered toner is caused to adhere to the printing form in the image area by melting the powdered toner in the image area. This method does not seem to apply to liquid toners because liquid toners are already in the liquid form. Accordingly, this method of differentiating the image area and the non-image area disclosed by Doyle would not be effective for liquid toner. Further, Doyle disclose that an air knife is used to remove the excess powder toner that is not part of the image (see page 6, lines 17-22). There is no teaching or suggestion that this method of toner removal would be effective for liquid toner. Although great deference should be attributed to the Board's decision, Applicants respectfully submit that the Board's interpretation of page 3, lines 7-9 of Doyle is incorrect and that there is no teaching or suggestion in Doyle that a liquid toner can be used to

practice the method taught by Doyle. Please reconsider the teaching of the above-identified portion of Doyle in view of the above remarks.

Furthermore, although Doyle shows that the printing form is grounded in Fig. 1, there is no teaching or suggestion that a charge is applied to it. Rather, a charge is applied to the powdered toner particles. Accordingly, Doyle also fails to teach or suggest charging of the entire printing form. As acknowledged in the Office Action, Doyle does not specifically disclose controlling the thickness of the fluid toner on a printing form.

Raschke fails to teach what Doyle lacks. Raschke discloses a device for making a reusable print master. Raschke also teaches the use of powdered toner. There is no teaching or suggestion that liquid toner could be used. Raschke discloses that a belt is charged and that a powdered toner is applied to the belt. The toner is also charged such that it adheres to the belt by electrostatic charge. After the powdered toner is applied to the belt, the charge on the powdered toner particles is discharged in the image area such that the toner particles in the background remain adhered to the belt by electrostatic charge and the toner particles in the image area are loose because of the discharge of charge (col. 4, lines 34-43). The image is then transferred in Raschke by pressing a master against the image such that only the loose toner particles in the image are transferred to the master (col. 4, lines 44-50). There is no teaching or suggestion that this method would be effective using liquid toner. In fact, it seems that if the liquid were contacted by the master, some of the liquid toner would be transferred from all areas of the belt and not just the image area. Accordingly, it is respectfully submitted that Raschke also fails to teach or suggest that a liquid toner could be used in the method disclosed by Raschke.

Calabrese discloses a method of making a lithographic plate using liquid toners. However, Calabrese specifically teaches that an electrostatic charge is selectively applied to the

surface of the printing plate in a pattern corresponding to the image to be printed (see col. 2, lines 41-44). Therefore, Calabrese discloses that when using liquid toner, a charge is selectively applied to the printing form before the liquid toner is applied to the printing plate. Even if the teaching of Calabrese were combined with the teaching of Doyle and Raschke, the combination fails to teach or suggest "electrically charging the printing form over its entire surface", "applying liquid toner particle to the printing form so that the toner particles are attracted to the entire surface of the printing form to form a layer", and then "fixing the liquid toner particles with a source of energy in accordance with a picture to be printed, and one of removing and breaking down non-fixed liquid toner particles to change ink acceptance behavior of the layer", as expressly recited in independent claim 1. In contrast, the combined teachings of Doyle, Raschke and Calabrese suggest that only powdered toner should be used in methods where the printing form is charged over its entire surface and toner is applied over the entire surface before imaging.

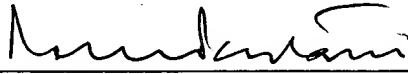
In view of the above remarks, it is respectfully submitted that independent claim 1 is allowable over Doyle in view of Raschke and Calabrese.

Dependent claims 2-10, 12-18, 20-22, and 29, being dependent on independent claim 1, are deemed allowable for the same reasons expressed above with respect to independent claim 1.

The application is now deemed to be in condition for allowance and notice to that effect is solicited.

Respectfully submitted,

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